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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/470,814 | 12/22/1999 | DALE F. MCINTYRE | 80353THC | 6645 |

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| EXAMINER |
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VIG, NARESH

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| ART UNIT | PAPER NUMBER |
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3629

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/470,814

Applicant(s)

MCINTYRE ET AL.

Examiner

Naresh Vig

Art Unit

3629

MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 3, 14 - 19, 29 and 33 - 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 3, 14 - 19, 29 and 33 - 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3629

DETAILED ACTION

This is in reference to response received on 09 January 2004 to the office action mailed on 07 January 2004. Claim 39 is not responded to because claim 39 was withdrawn from consideration during the Interview 10 September 2003. There are 16 claims, claims 1 – 3, 14 – 19, 29 and 33 – 38 pending for examination.

Response to Arguments

Applicant's arguments with respect to claims 1 – 3, 14 – 19, 29 and 33 – 38 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3629

Claims 1 – 3 and 33 – 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over an article “Kodak To Deliver Digital Photos Via AOL” by GlobeAndMail.com hereinafter known as GlobalMedia in view of an article “AOL And Kodak To Offer Online Photo Delivery Service” by ComputerWire, Inc. hereinafter known as ComputerWire.

Regarding claim 1, GlobalMedia discloses America Online (AOL) will allow members to have images from developed film sent digitally for an additional \$5 to \$7 per roll of film to a custom AOL feature called "You've Got Pictures. GlobalMedia discloses AOL users will receive digital contact sheets of same photos in their AOL photo mailbox (storing and viewing a collection of digital images).

GlobalMedia does not disclose providing a plurality of users each with a unique user ID associated with an event URL identifying a network service provider and a share memory image storage location at said network photoservice provider for sharing of image among said plurality of users without the need for any of the users having to notify any of the other of said users. However, ComputerWire discloses AOL users can give their screen name (location on AOL system where the retailer can upload the pictures, and, from where the user can retrieve their pictures from) to the retailer to have the digital images sent to them. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that Universal Resource Locator (URL) is used to locate the resources over the internet which identifies the sever and the location on the server where the information is stored.

Art Unit: 3629

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify GlobalMedia as taught by ComputerWire to be able to create additional web hosting services.

GlobalMedia does not disclose providing each one of the plurality of users with a separate password associated with the unique user ID. However, ComputerWire discloses users can obtain screen-name from AOL to view pictures. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify GlobalMedia as taught by ComputerWire to implement security on the system.

GlobalMedia discloses one of the plurality of users (retailer) transferring a set of digital images to the network image provider (AOL) for storage. GlobalMedia does not disclose users (retailers) employing their separate user IDs and passwords. However, Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made to businesses have used user-id and password combinations to secure access to their systems. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use user-id and password combinations to secure the system form unauthorized use.

GlobalMedia discloses viewing the images located at the share image storage location at said network image provider using unique user ID and the separate password (AOL screen-name).

Art Unit: 3629

Regarding claim 2, GlobalMedia discloses digital images transferred to the user using said user ID are relatively high resolution images (Higher resolution pictures will be available by request) and the images viewed at the share memory storage location are relatively low resolution images (thumbnails).

Regarding claim 3, GlobalMedia discloses providing a high resolution print from a digital image associated with the unique user ID (Higher resolution pictures will be available by request).

Regarding claim 33, GlobalMedia discloses accessing a collection of digital images stored at a share memory storage location at a network service provider (AOL) among plurality of users without the need for any of said group having to notify any of the others in the group (AOL informs users "You've Got Pictures").

registering an event (screen-name with an event) with a network photo service provider.

transferring a set of digital images to the event specific URL;

providing to a plurality of users access to the event specific URL; and

employing the event specific URL to access the images among said group of users.

Art Unit: 3629

GlobalMedia does not disclose providing a plurality of users each with a unique (event specific) URL (screen-name) to the registered event which identifies said share image memory location. However, ComputerWire discloses AOL users can give their screen name (location on AOL system where the retailer can upload the pictures, and, from where the user can retrieve their pictures from) to the retailer to have the digital images sent to them. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that Universal Resource Locator (URL) is used to locate the resources over the internet which identifies the sever and the location on the server where the information is stored. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify GlobalMedia as taught by ComputerWire to be able to create additional web hosting services.

Regarding claims 34, 35, GlobalMedia in view of ComputerWire does not disclose providing a transaction card bearing the event specific URL. However, Carson discloses providing card with PIN (password) with information to access the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify GlobalMedia in view of ComputerWire as taught by Carson to help the user remember the information to use the system.

Art Unit: 3629

Regarding claim 36, GlobalMedia in view of ComputerWire does not disclose AOL user is a professional photographer, and charging a royalty for use of the uploaded digital images. However, neither does GlobalMedia disclose that AOL has limited the users to non-professionals only. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is business choice to elect what type of users can access the system. GlobalMedia discloses that AOL users can share the photo albums with other users. For a fee, framed prints can be ordered. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify GlobalMedia in view of ComputerWire and allow professional photographers to use the system to expand the user base.

Regarding claim 37, GlobalMedia in view of ComputerWire does not disclose transaction card includes printed advertising. However, Carson discloses card to have area for printing messages (e.g. instructions). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify GlobalMedia in view of ComputerWire as taught by Carson to generate additional revenue by providing advertising services.

Regarding claim 38, GlobalMedia discloses additional merchandise could include digital cameras.

Art Unit: 3629

GlobalMedia does not disclose digital images are from a scanner or an electronic camera. However, ComputerWire discloses that digital images can be scanned and uploaded. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify GlobalMedia as taught by ComputerWire to be able to convert the picture in digital format to be uploaded on the storage device.

Claims 14 –19 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over an article “Kodak To Deliver Digital Photos Via AOL” by GlobeAndMail.com hereinafter known as GlobalMedia in view of an article “AOL And Kodak To Offer Online Photo Delivery Service” by ComputerWire, Inc. hereinafter known as ComputerWire and further in view of Carson US Patent 6,028,920.

Regarding claims 14, 15 and 29, GlobalMedia discloses AOL allows users to share (permitting access by a pre-determined group of users) photo albums (electronically stored images) over the internet.

GlobalMedia does not disclose providing each member of the group of users with a unique transaction card, selected from a related set of cards, each card in the related set further comprising. GlobalMedia does not disclose providing a plurality of users each with a unique user ID associated with an event URL identifying a network service provider and a share memory image storage location at said network photoservice

Art Unit: 3629

provider for sharing of image among said plurality of users without the need for any of the users having to notify any of the other of said users. However, ComputerWire discloses AOL users can give their screen name (location on AOL system where the retailer can upload the pictures, and, from where the user can retrieve their pictures from) to the retailer to have the digital images sent to them. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that Universal Resource Locator (URL) is used to locate the resources over the internet which identifies the sever and the location on the server where the information is stored. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify GlobalMedia as taught by ComputerWire to be able to create additional web hosting services. GlobalMedia in view of ComputerWire does not disclose issuing cards for unique ids. However, Carson discloses system and method providing services to users. A card has a personal identification number (PIN) which can be covered by a removable opaque coating (unique transaction card) [abstract]. Cards can be associated with a group [col. 5, lines 24 – 35]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify GlobalMedia in view of ComputerWire as taught by Carson and use transaction card to help users remember their system access information.

GlobalMedia in view of ComputerWire does not disclose a support sheet upon which are printed instructions for use of the transaction card. However, Carson discloses that card is imprinted with the toll free number and instructions for users to follow in order to place calls (use the system) in association with the card. Therefore, it

Art Unit: 3629

would have been obvious to one of ordinary skill in the art at the time the invention was made to modify GlobalMedia in view of ComputerWire as taught by Carson to help users follow the instructions to use the system.

GlobalMedia in view of ComputerWire does not disclose a removable label affixed to the support sheet having an adhesive backing, the label having a first machine readable URL printed on it which is associated with the related set of cards and is unique to the related set, said machine readable URL identifying a network service provider and a share memory image storage location at said network photoservice provider for sharing of images among said group of users without the need for any of the users having to notify any of the other of said users. However, Carson discloses card with removable coating [label] affixed to the card and other information [Fig. 5, 6, col. 7, lines 49 – 57]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify GlobalMedia in view of ComputerWire as taught by Carson to limit the exposure of the security invention to the intended user.

GlobalMedia in view of ComputerWire does not disclose a second unique human readable password printed on the support sheet and revealed only when the removable label is removed from the card, the human readable password permitting access to the images associated with the roll of film or camera when the password is input to a computer connected to said network photoservice provider. However, GlobalMedia discloses AOL permitting access to the images associated with the roll of film or camera when the password is input to a computer connected to said network photoservice

Art Unit: 3629

provider. Carson discloses second unique human readable information [Fig. 5, 6].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify GlobalMedia in view of ComputerWire as taught by Carson to limit the exposure of the security invention to the intended user.

GlobalMedia in view of ComputerWire and Carson does not disclose sheet with removable labels which can be affixed to another item (removing the removable label from at least one card in the related set and affixing the label to an exposed roll of film or one-time use camera at the time of submission of the roll or camera for processing). Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that businesses have used labels to identify products for services. For example, medical test performed in a lab. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made modify GlobalMedia in view of ComputerWire and Carson and use labels to match the item with the owner.

GlobalMedia discloses AOL users can take their film (roll, one-time user camera) to a retailer for electronically scanning and storing the images produced.

GlobalMedia does not disclose reading the unique machine readable URL (screen name) and uploading the scanned images to a network photoservice provider identified by the URL. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that a user has to know the address of the destination (URL, IP Address etc.) to load the information at that load.

Art Unit: 3629

GlobalMedia discloses AOL users accessing the images uploaded to the network photoservice provider (AOL). GlobalMedia does not disclose access to information by any member of the pre-determined group of users holding a card from the related set of cards, access being obtained by the cardholder inputting the human readable password associated with the particular cardholder's card. Carson discloses access to system by users having the card with the PIN. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify GlobalMedia as taught by Carson to limit the access to the information to the authorized users only.

GlobalMedia does not disclose that in the event that a user fails to designate images for access to all card holders within a predetermined period of time, granting access to all images stored at said memory image storage location by the user to all cardholders (default action taken by the system). However, ComputerWire discloses default action taken by AOL when user does not post the images to an album). Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to elect what default action to take when the user does not take action.

Regarding claims 16 and 18, GlobalMedia discloses along with Kodak and AOL, more that 30,000 retail film processing outlets will share the revenue (further providing access to additional users to upload set of digital images to an image storage location at said network service provider associated with the unique user ID).

Regarding claims 17 and 19, GlobalMedia in view of ComputerWire and Carson does not disclose AOL user is a professional photographer, and charging a royalty for use of the uploaded digital images. However, GlobalMedia does not disclose that AOL has limited the users to non-professionals only. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is business choice to elect what type of users can access the system. GlobalMedia discloses that AOL users can share the photo albums with other users. For a fee, framed prints can be ordered. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify GlobalMedia in view of ComputerWire and Carson and allow professional photographers to use the system to expand the user base.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Press Release "America Online To Introduce Next-Generation Of AOL – AOL 5.0 – Later This Year".
2. How About Kodak And AOL Joining Forces.....?

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

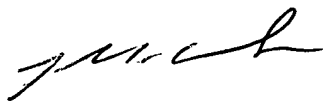
Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Naresh Vig
April 2, 2004


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600